

REMARKS

The Office Action rejects claims 1-17. These rejections are respectfully traversed below, and reconsideration of all rejected claims is respectfully requested.

Applicant cancels claims 2 and 16 without prejudice or disclaimer, amends claims 1, 3, 5, 10, 13, 14, and 15, and adds new claim 18, which depends from claim 3.

Accordingly, claims 1, 3-15, 17 and 18 are pending.

Rejection of Claims 2-7 Under 35 U.S.C. §112, first paragraph

The Office Action rejects claims 2-7 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Point 2 of the Office Action asserts, "the specification fails to describe how one skilled in the art would make a hologram capable of achieving these functions," (the functions recited in claims 2-7). This rejection is respectfully traversed.

Contrary to the Office Actions comments, it is respectfully noted that it is not necessary that the application describe the claim limitations exactly, but only so clearly that persons of ordinary skill in the art will recognize from the disclosure that appellants invented processes including those limitations. In re Wertheim, 191 USPQ 90, 96 (CCPA 1976). Similarly, "[the specification] need only be reasonable with respect to the art involved; they need not inform the layman nor disclose what the skilled already posses. They need not describe the conventional...The intricacies need not be detailed ad absurdum." General Electric Co. v. Brenner, 159 USPQ 335 (D.C. Cir. 1968). In addition, a defining aspect of enablement is that there isn't undue experimentation, i.e., experiment required to reproduce the claimed features is satisfactory, as long as it isn't undue experimentation. In re Geerdes, 180 USPQ 789, 793 (CCPA 1974).

Accordingly, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art, after review of the present invention and disclosure, to form a hologram on a second surface of a beam splitter which is capable of achieving the functions recited in claims 2-7.

Further, "[a] specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement....unless there is a reason to doubt the objective truth of the statements contained therein which must be relied upon for enabling support." MPEP § 2164.04.

In addition, as noted in MPEP § 2163.04, a "description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption." The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The Examiner has the initial burden of presenting by the a preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention as defined by the claims.

It is respectfully submitted that Office Action has failed to meet this burden, and accordingly failed to set forth a *prima facie* enablement rejection.

Accordingly, for at least these reasons, withdrawal of the rejection of claims 2-7 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Rejection of Claims 5, 13 and 14 Under 35 U.S.C. §112, second paragraph

The Office Action rejects claims 5, 13, and 14 under 35 U.S.C. §112, second paragraph because these claims include terms having insufficient antecedent basis. Applicants amend claims 5, 13 and 14 to obviate this rejection. In addition, claim 18 is added to depend from claim 3.

Accordingly, withdrawal of the rejection of claims 5, 13, and 14 under 35 U.S.C. §112, second paragraph is respectfully requested.

Rejection of Claims 1-17 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1-17, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,392,977 to Ando et al. (hereinafter referred to as "Ando") in view of U.S. Patent 5,659,531 to Ono et al. (hereinafter referred to as "Ono"). This rejection is respectfully traversed.

It is respectfully submitted that Ando and Ono, taken separately or in combination, fail to disclose, teach or suggest at least, "a second light source to generate a second light beam whose optical access is parallel to the optical access of the first light beam," as recited in claim 1.

The Office Action assets that Ando discloses "a second light source (L2) to generate a second light beam 3(b) whose optical axis is parallel to the optical axis of the first light beam (column 4, lines 62 – 65)."

However, Ando discloses, "The first semiconductor laser 3a and the second semiconductor laser 3b are arranged so that optical axes of the first and second light beams L1, L2 will cross each other," (column 4, lines 62-65).

Because "first and second light beams L1, L2 of Ando cross each other," first light beam L1 cannot have an optical axis which is parallel to the optical axis of the second light beam L2. As shown in Figure 1, it appears that the light sources 3A, 3B are producing light beams L1, L2, which are perpendicular to each other.

Moreover, Figure 11 of Ono shows three light sources 210, 230 and 231 whose light beams also cross each other. Thus, as neither reference discloses or suggested at least this claimed feature, it is further submitted that as a whole the references similarly would fail to disclose or suggest the same.

Therefore, for at least these reasons claim 1 patentably distinguishes from the cited references.

Claim 2 is cancelled without prejudice or disclaimer.

Claims 3-9 and 18 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claims 3-9 and 18 also patentably distinguish over the cited references.

Similarly, Ando and Ono, taken separately or in combination, do not disclose, teach or suggest at least, "applying a voltage to one of the light sources to cause a light beam to be admitted, wherein the optical axis of one light source is in parallel with the optical axis of the other light source," as recited in claim 10. Therefore, for at least these reasons, claim 16 patentably distinguishes from the cited references.

Claims 11-14 depend from claim 10 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Therefore, it is respectfully submitted that claims 11-14 also patentably distinguish over the cited references.

Similarly, Ando and Ono, taken separate or in combination, do not disclose, teach or suggest at least, "a second light source to generate a second light beam whose optical axis is parallel to the optical axis of the first light beam, the second light source being disposed optically farther from a recording medium than the first light source," as recited in claim 15. Therefore, for at least these reasons, claim 15 patentably distinguishes from the cited references.

Claim 17 depends from claim 15 and include additional features which are not taught or suggested by the cited references. Therefore, for at least these reasons, claim 16 also patentably distinguishes over the cited references.

Rejection of Claims 1, 8, 9, 15 and 16 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 8, 9, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Ono.

Applicant amends claim 1 to include features of claim 2. Accordingly, claim 1 has the same scope as original claim 2. In addition, Applicant amends claim 15 to include features from claims 2 and 16. Claims 2 and 16 are cancelled without prejudice or disclaimer.

Applicant's Admitted Prior Art and Ono, taken separately or in combination, fails to disclose, teach or suggest at least, "wherein the hologram is formed to diffract the first light beam into a relatively more +1-order diffracted light beam and relatively less residual light, and to diffract the second light beam into a relatively more zero-order diffracted light beam and relatively less residual light," as recited in claim 2 and similarly recited in claim 15.

Therefore, for at least these reasons, claims 1 and 15 patentably distinguish over the cited references.

Claims 8 and 9 depend from claim 1 and include all the features of that claim plus additional features not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claims 8 and 9 also patentably distinguish over the cited references.

Summary

Claims , claims 1, 3-15, 17 and 18 are pending and under consideration. It is respectfully submitted that none of the references taken separately or in combination disclose the present claimed invention.

There being no further outstanding objections or rejections, it is respectfully submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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